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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,268	01/12/2001	Hakaru Matsui	3008-16	9210

7590

10/23/2002

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 10/23/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group/Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/29/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11, 15-27 is/are pending in the application.
- Of the above claim(s) 5-11, 25-27 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4, 15-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Newly submitted claims 25-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons as set forth in Paper No. 5, Groups II and/or III.
2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the

obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 17-18, and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 11293365 (PTO-1449, abstract and Figure 1), JP 51045528, JP 11293431, or JP 2000169918.

6. Claims 1, 3, 17-18, 20, 22, and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 05051675.

7. Claims 1-3 and 17-24 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 57070244 or DD 290501.

8. The cited reference(s) disclose(s) the features including the claimed Cu based alloy composition. The features relied upon described above can be found in the reference(s) at their abstracts. The difference between the reference(s) and the claims are as follows: cited references do not disclose each alloying element purity level. However, it is well settled that the difference in degree of purity itself does not predicate invention. In re Merz, 38 USPQ 143 and In re King et al, 43 USPQ 400. Furthermore, the claimed alloying elements may have high purities but said purities are found inconsistent with the instant claimed copper alloy wires compositions which have an open transitional expression "comprising" to include unrecited ingredients in major amounts. See Ex parte Davis et al. (POBA 1948) 80 USPQ 448

and In re Bertsch 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

9. JP 05051675, JP 57070244, and DD 290501 do not disclose the wire diameter. But, as are evinced by JP 51045528, JP 11293431, or JP 2000169918 that the claimed wire size is a conventional high strength wire size. Accordingly, it would have been prima facie obvious for an ordinary skill artisan motivated by a reasonable expectation of success to use the alloys of JP 05051675, JP 57070244, and DD 290501 for wire in order to obtain all of the known benefits. In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

10. Claims 4 and 15-16 are rejected under 35 U.S.C. § 103 as being unpatentable over references as applied to claims above in view of JP 61113740 and further teaching of JP 02204919.

11. The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for the purities of the copper and other elements and plating the wires. However, JP 6113740 in abstract teaches 5N purity copper is conventionally use for wires in the same field of endeavor or the analogous metallurgical art for improving conductivity. Moreover, it is well settled that the difference in degree of purity itself does not predicate invention. In re Merz, 38 USPQ 143 and In re King et al, 43 USPQ 400. JP 02204919 in abstract disclose that plated wire to improve coil feeding and solderability. Therefore, it would have been obvious to one having

ordinary skill in the art of the cited references at the time the invention was made to plate the wire as taught by JP 02204919 in order to improve/provide coil feeding and solderability. In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233.

Response to Arguments

12. Applicant's arguments filed July 29, 2002 have been fully considered but they are not persuasive.

13. Applicants' argument with respect to '365, '528, '431, '918, '675, '244, '501, '740, and '919 is noted. But, the claimed purity of each element is prior forming the claimed wire and is not existed in the final product. Furthermore, the claimed purity of each element prior to form the claimed wire is immaterial to the purity of the final wire product because the claimed wire compositions have an open transitional expression "comprising" which is inclusive and fails to exclude unrecited ingredients even in major amounts. See Ex parte Davis et al. (POBA 1948) 80 USPQ 448 and In re Bertsch 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

14. Applicants argue the purity disclosed by JP '740 is after the alloying elements being combined not prior being combined to form the copper alloy wire. But, if it is known in the art of cited references to control purity in the final product, it is

obvious/known to control purity of each ingredient prior to combine in order to reduce processing cost and increase product yield.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542.

Serial No: 09/758,268
Art Unit: 1742


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The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone numbers are (703) 872-9310 (non-final Official Paper only), (703) 872-9311 (after-final Official Paper only), and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
October 20, 2002